

### **REMARKS**

These remarks respond to the Official Action dated April 19, 2010. Claims 31, 32, 35, 37, 39, 40, 47, 53, 62-64, 73, 74 and 79-81 have been withdrawn and Claims 1, 2, 10, 17 and 21 have been rejected over the prior art. Favorable reconsideration of this application in view of the following remarks is respectfully requested.

#### **Rejection under 35 U.S.C. §102**

The Official Action rejected Claims 1, 2 and 17 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent Application Publication No. 2002/0062834 to Snaidr et al. ("Snaidr").

Specifically, the Official Action alleges that:

Regarding claim 1, Snaidr discloses a smoking article comprising: a tobacco rod (54, fig. 6) having a wrapper (10, fig. 6) formed around the tobacco rod, the wrapper including a patterned (18, fig. 6) deposit on at least a portion of one surface of the wrapper, wherein the pattern [sic] deposit comprises catalyst particles [sic] of catalyzing, oxidizing and/or reducing the conversion of a constituent gas component in the mainstream and/or sidestream smoke of the smoking article (abstract and paragraph 57). (Official Action at page 2).

Claim 1 recites a smoking article comprising: a tobacco rod having a wrapper formed around the tobacco rod, the wrapper including a patterned deposit on at least a portion of one surface of the wrapper. The patterned deposit comprises catalyst particles capable of catalyzing, oxidizing and/or reducing the conversion of a constituent gas component in the mainstream and/or sidestream smoke of the smoking article.

Snaidr discloses a low sidestream smoke cigarette including a combustible treatment paper having a sidestream smoke treatment composition including an oxygen storage and donor metal oxide oxidation catalyst (Abstract). The sidestream smoke treatment composition may be applied to one or both sides of cigarette paper to virtually eliminate sidestream smoke (paragraphs [0065] and [0072]). However, Snaidr fails to disclose a patterned deposit or discontinuous coating of any kind.

To anticipate a claim, the applied reference must disclose all features of the claim. In addition, "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102" (Emphasis Added). *Net Money/IN, Inc. v. Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008).

In this case, Claim 1 is not anticipated by Snaidr at least because Snaidr fails to disclose a patterned deposit as recited in Claim 1. Instead, Snaidr discloses coatings which virtually eliminate sidestream smoke, but fails to disclose a discontinuous coating of any kind (paragraph [0072]). As set forth in §2111 of the MPEP:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

Additionally, in *In re Morris*, the court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a

court would interpret claims in an infringement suit. Rather, the PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Here, the Official Action has failed to give Claim 1 its broadest reasonable interpretation consistent with the specification. As described in the specification, the patterned deposit includes regions of the cigarette wrapper that are left unprinted and available to facilitate diffusion of CO through the wrapper (paragraph [0040]). Without such uncoated areas, there would be no pattern to be seen. Here, Snaidr fails to disclose any uncoated areas, and in fact seeks to virtually eliminate sidestream smoke (paragraph [0072]). As such, Snaidr fails to disclose a patterned deposit, and Claim 1 is not anticipated by Snaidr.

Claims 2 and 17, which depend from Snaidr are also not anticipated for at least the reasons Claim 1 is not anticipated.

### **Rejections under 35 U.S.C. §103**

a. The Official Action rejected Claim 10 under 35 U.S.C. §103(a) as allegedly unpatentable over Snaidr in view of U.S. Patent No. 3,636,027 to Smith ("Smith").

Claim 10, which depends from Claim 1, is patentable at least because Snaidr fails to teach or suggest, and in fact teaches away from, a patterned deposit as recited in Claim 1, and Smith fails to remedy the deficiencies of Smith.

b. The Official Action rejected Claim 21 under 35 U.S.C. §103(a) as allegedly unpatentable over Snaird.

Claim 21, which depends from Claim 1, is patentable at least because Snaird fails to teach or suggest, and in fact teaches away from, a patterned deposit as recited in Claim 1, and Smith fails to remedy the deficiencies of Smith.

### **Conclusion**

In view of the foregoing, it is submitted that all claims are in condition for allowance. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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